

Docket No.: 17250/018001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Jean-Luc Dauvois

22511
PATENT TRADEMARK OFFICE

Application No.: 10/538,725

Confirmation No.: 6778

Filed: June 13, 2005

Art Unit: Not Yet Assigned

For: METHOD FOR ACCESS CONTROL IN
DIGITAL PAY TELEVISION

Examiner: Not Yet Assigned

SECOND RENEWED PETITION UNDER 37 C.F.R. § 1.47(b)

MS PCT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In connection with the Applicant's response to the Decision on Petition ("Decision") mailed May 3, 2007, please consider the following second renewed petition under 37 C.F.R. § 1.47(b).

In the Notice, the Examiner indicates that only item (5) (*i.e.*, proof of proprietary interest) remains to be satisfied, and that all other requirements have been met. In an attempt to satisfy item (5), Applicant hereby submits a Declaration by Christophe Oddou, Head of System Architecture Department at Canal+ Technologies, asserting that Jean-Luc Dauvois worked for Canal+ Technologies as the head of the Cryptographic Department until June 15, 2002. Mr. Oddou's declaration also authenticates two organizational charts of internal hierarchy of Canal+ Technologies managers and supervisors. Mr. Oddou's declaration and the organizational charts show that Jean-Luc Dauvois held a supervisory position at during his employment with Canal+ Technologies, and was in a position to be directly involved with patentable, inventive concepts.

Further, Applicant submits a “Transaction Protocol” (original in French, with an English Translation) that establishes that Jean-Luc Dauvois was the inventor for eleven (11) applications while he was employed with Canal+ Technologies. The eleven applications are listed on page 2 of the English Translation of the Transaction Protocol. While the applications are listed with internal Canal+ Technologies reference numbers, the Transaction Protocol shows that each of the eleven applications had to be prepared and filed by in-house attorneys. Thus, as the Examiner points out in the Decision mailed May 3, 2007, the delay in filing the French application from which PCT/FR03/50181 claims priority was due to in-house attorneys at Canal+ Technologies preparing and filing the patent applications for which Jean-Luc Dauvois was an inventor. This explains the gap in time between when Mr. Dauvois was employed by Canal+ Technologies (September 6, 2002) and when the French application (FR 0301243) was filed (December 17, 2002). As further evidence of proprietary interest, in the Transaction Protocol, which is executed by Jean-Luc Dauvois, the inventor acknowledges that the eleven patent applications are the full and entire property of the Company (Canal+ Technologies) (*see* translation of Transaction Protocol, bottom of page 2). Further, an e-mail dated July 26, 2007, from Natalie Zaugg, who represents Canal+ Technologies and Nagra Thomson Licensing, indicates that internal reference number I2002-013, listed in the Transaction Protocol, corresponds to the present application, Application Serial No. 10/538,725.

Finally, Applicant has provided an English translation of copies of the letters and memorandums from Canal+ Technologies (exhibits 4-6 and 8-9), as requested by the Examiner in the Decision mailed May 3, 2007.

The further evidence provided by this petition, along with the previously filed evidence, establishes that Canal+ Technologies has sufficient proprietary interest in the referenced application. The Declaration made by Gerard Delile establishes that Jean-Luc Dauvois made the

referenced invention while employed by Canal+ Technologies and that Canal+ Technologies rightfully owns the present invention under French law. As previously submitted, Canal+ Technologies underwent a name change from Canal+ Technologies to Nagra Thomson Licensing on June 21, 2004. Thus, Nagra Thomson Licensing has sufficient proprietary interest in the referenced application. Thus, Applicant believes that item (5) is now satisfied.

Applicant believes that this renewed petition, combined with the previously submitted evidence included in the original 37 C.F.R. § 1.47(b) petition filed on July 7, 2006, satisfy all the elements required under 37 C.F.R. § 1.47(b). In light of the petitioner's diligent attempts to obtain the signature of the inventors and, pursuant to 37 C.F.R. § 1.47(b), the petitioner requests that the referenced application be examined without the signed Declaration of Jean-Luc Dauvois. Such action is necessary to preserve the rights of the Applicant and to prevent irreparable damage which may be caused by the loss of foreign rights for the Applicant.

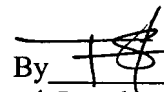
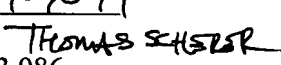
The verified last known address of Jean-Luc Dauvois is:

80 rue des Victimes du Nazisme, 72000 Le Mans, France.

We believe this petition addresses all outstanding issues raised in the Decision mailed on May 3, 2007. If this belief is in correct, please feel free to contact the undersigned. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 17250/018001).

Dated: October 3, 2007

Respectfully submitted,

By  #45,079
Jonathan P. Osha 
Registration No.: 33,986
OSHA · LIANG LLP
1221 McKinney St., Suite 2800
Houston, Texas 77010
(713) 228-8600
(713) 228-8778 (Fax)
Attorney for Applicant

Attachments (Declaration by Chistophe Oddou with Organizational Charts)
("Protocole Transactionnel" with English Translation)
(Translation of Exhibits 4-6 and 8-9).

PROTOCOLE TRANSACTIONNEL

ENTRE :

La Société Canal+ Technologies, société anonyme au capital de 228.899.957 francs, dont le siège social est situé 34, Place Raoul Dautry, 75516 Paris cedex 15, représentée par Monsieur Luc GERMAIN, en qualité de Directeur des Ressources Humaines France,

Ci-après désignée « *la Société* »

D'une part,

ET :

Monsieur Jean-Luc DAUVOIS, demeurant 19, rue Eugène Manuel 75016 Paris.

Ci-après désigné « *M.Dauvois* »

D'autre part,

l
JLD

Article 3 Concessions de M. Dauvois

3.1 M. Dauvois convient que son contrat de travail prendra fin à la date du 6 septembre 2002, date d'expiration de son préavis.

Au regard des concessions effectuées par la Société, M. Dauvois accepte de ne pas donner suite à ses contestations, tant sur le fond que sur la procédure ayant conduit à son licenciement.

M. Dauvois reconnaît que les concessions faites par l'employeur sont réalisées à titre transactionnel, forfaitaire et définitif, conformément aux dispositions des articles 2044 et suivants du Code Civil, et en particulier de l'article 2052 dudit Code, ceci afin de le remplir de tous ses droits et pour mettre fin à tout différend né ou à naître des rapports de droit ou de fait ayant pu exister entre la Société et les Sociétés du Groupe Canal+ d'une part et M. Dauvois d'autre part.

3.2 M. Dauvois reconnaît, en tant que de besoin, qu'en application de l'article L 611-7 1°) du CPI, l'intégralité des droits de propriété intellectuelle sur les inventions auxquelles M. Dauvois a participé dans le cadre des missions inventives qui lui ont été confiées pendant les années de sa collaboration avec les sociétés SECA et Canal+ Technologies et notamment celles qui ont fait l'objet d'un dépôt valant classement en invention de mission, sont la propriété pleine et entière de la Société et que la rémunération stipulée à l'article 2.1 couvre la rémunération prévue audit article.

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M. Dauvois reconnaît, en outre, que conformément à l'article L 113-9 du CPI l'ensemble des droits patrimoniaux relatifs à tout ou partie des logiciels (en ce compris leur documentation) à l'élaboration desquels il a été amené à participer sont la propriété exclusive de la Société.

M. Dauvois s'engage à faire dans les meilleurs délais ou à s'abstenir de faire tout ce que la Société pourrait, le cas échéant, lui demander de faire ou de s'abstenir de faire afin de permettre à la Société de pouvoir exercer les droits ou de se prévaloir, de quelque façon que ce soit, des droits que M. Dauvois reconnaît ci-dessus être la propriété de la Société.

Enfin M. Dauvois s'engage à fournir tous les éléments nécessaires au dépôt des brevets suivants :

- I2000-022
- I2001-015
- I2001-022
- I2002-011 (Fiche d'invention « notoirement » incomplète)
- I2002-012 (Fiche d'invention « notoirement » incomplète)
- I2002-013 (Fiche d'invention « notoirement » incomplète)
- I2002-014 (Fiche d'invention « notoirement » incomplète)
- I2002-015 (Fiche d'invention « notoirement » incomplète)
- I2002-016 (Fiche d'invention « notoirement » incomplète)
- I2002-017 (Fiche d'invention « notoirement » incomplète)
- I2002-018 (Fiche d'invention « notoirement » incomplète)

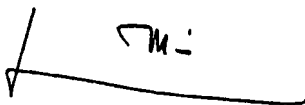
En outre, il s'engage à signer les documents d'extension et reconnaît que ces brevets sont la propriété pleine et entière de la Société et que la rémunération stipulée à l'article 2.1 couvre la rémunération prévue audit article.

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8. déclarent que le présent Accord aura, entre les parties, le même effet juridique qu'une décision judiciaire passée en force de chose jugée.

Fait en deux originaux à Paris, le 13 juin 2002

Lu et approuvé.
Bon pour Transaction
irrévocable et
désistement de tous droits,
instances et actions



Pour la Société Canal+ Technologies
Luc Germain

(Faire précéder la signature de la mention manuscrite :
« Lu et approuvé. Bon pour transaction irrévocable et
désistement de tous droits, instances et actions »)

Lu et approuvé. Bon pour
Transaction irrévocable et désistement
de tous droits, instances et actions. Bon
pour quittance des sommes visées dans
le corps des présentes. Bon pour
renonciation à tout recours contre la
Société et toute autre société
du Groupe Canal+



Jean-Luc Dauvois

(Faire précéder la signature de la mention manuscrite :
« Lu et approuvé. Bon pour transaction irrévocable et
désistement de tous droits, instances et actions. Bon
pour quittance des sommes visées dans le corps des
présentes. Bon pour renonciation à tout recours contre
la Société et toute autre société du Groupe Canal+ »)

Transaction Protocol

BETWEEN :

The Company Canal+ Technologies, share holders company with a capital of 228.899.957 Francs, of which the registered office situated, 34, Place Raoul Dautry, 75516 Paris Cedex 15, represented by Mr Luc GERMAIN, as Director France of Human Ressources,

hereafter designated “the Company”

in another hand,

AND :

Mr Jean-Luc Dauvois, domiciled 19, rue Eugène Manuel 75016 Paris.

hereafter designated “Mr Dauvois”,

in another hand,

Article 3 Concession of Mr Dauvois

3.1 Mr Dauvois agrees that his contract of employment will end on September 6, 2002, date of expiration of his cancellation notice.

In view of the concessions made by the Company, Mr Dauvois accepts not to pursue on his contestations, as long as the substance or the proceeding is concerned, having conducted to his redundancy notice.

Mr Dauvois recognizes that the concessions made by the employer are realized as transactional purpose, contractual and final, according to the articles 2044 and following of the civil code, and in particular the article 2052 of the civil code, so as to fulfill all his rights and to close all disputes arising or that could arise based on rights or facts having existed between the Company and the companies of the Canal + group on one side and Mr Dauvois in the other side.

3.2 Mr Dauvois recognizes, if needed, in virtue of the Article L 611.7 of the CPI, that the whole Intellectual Property Rights in relation with which Mr. Dauvois has participated in the frame of inventive missions for which he was entrusted during the collaboration period with the companies SECA and Canal + Technologies and in particular these for which the an application was filed, classified as invention made in the frame of the employment contract, are the full and entire property of the Company and payment as stated in article 2.1 covers the payment foreseen in said article.

Mr Dauvois further recognizes, in virtue of article L 113-9 of the CPI, that the whole of the patrimonial rights relating to all or part of the software (including the documentation) for which he works out are the exclusive property of the Company.

Finally, Mr Dauvois commits himself to furnish all necessary elements of the filing of the following applications :

- I2000-022
- I2001-015
- I2001-022
- I2002-011 (intervention sheet" notoriously" incomplete)
- I2002-012 (intervention sheet" notoriously" incomplete)
- I2002-013 (intervention sheet" notoriously" incomplete)
- I2002-014 (intervention sheet" notoriously" incomplete)
- I2002-015 (intervention sheet" notoriously" incomplete)
- I2002-016 (intervention sheet" notoriously" incomplete)
- I2002-017 (intervention sheet" notoriously" incomplete)
- I2002-018 (intervention sheet" notoriously" incomplete)

Moreover, he commits to sign documents of extension and recognizes that these patents are the full and entire property of the Company and that the payment stipulated in the article 2.1 covers the payment foreseen in this article.

8. Herewith declare that the present agreement will have, between the parties, the same effect as a court decision entered into force.

Seema Mehta

From: Nathalie Zaugg [nathalie@leman-ips.ch]
Sent: Thursday, July 26, 2007 3:05 AM
To: Seema Mehta
Subject: RE: [URGENT REMINDER] US Patent Applications - Jean-Luc Dauvois

Dear Seema,

Our client has located only few numbers.

Reference	Application No	Our Reference
12002-013	10/538,725	P-13-0222-US
12002-014	WO03075233	
12002-015	10/544,009	P-13-0301-US

Best regards,

Nathalie Zaugg
 Legal Assistant of Mr Joel Wenger
 Lemman Consulting S.A. - Intellectual Property Rights
 Chemin de Précossy 31 - 1260 Nyon - Switzerland
 Tel. +41(0)22 363 78 78 Fax +41(0)22 363 78 70
nathalie@leman-ips.ch

From: Seema Mehta [mailto:Mehta@oshaliang.com]
Sent: mercredi, 25. juillet 2007 18:08
To: Nathalie Zaugg
Cc: Debra V. Wieser; Salena L. Gourrier; John Osha; Aly Z. Dossa
Subject: [URGENT REMINDER] US Patent Applications - Jean-Luc Dauvois
Importance: High

Nathalie:

As a reminder, we are still awaiting any further information from you regarding the correlation between the 11 patent applications listed in the "protocole transactionnel" with internal reference numbers, and reference numbers for the patent applications filed with JLD listed as the inventor.

In the meantime, please do not hesitate to contact us if you have any questions.

Best regards,

Seema Mehta

OSHA • LIANG LLP

www.oshaliang.com

713.228.8600 (Main)

713.228.8778 (Fax)

CONFIDENTIALITY NOTICE

10/2/2007

Declaration


I, Christophe Oddou, Head of System Architecture Department at Canal + Technologies during the period of March 1, 1999 to December 31, 2003 herewith confirm that Jean-Luc Dauvois has worked within this company during the period of March 1, 1999 to June 15, 2002 as Head of Cryptographic Department.

I confirm that the attached organizational charts represent the organization of Canal + Technologies on May 9, 2001 and May 6, 2002.

Date : 12 June 2007

Location : Paris

Signature :



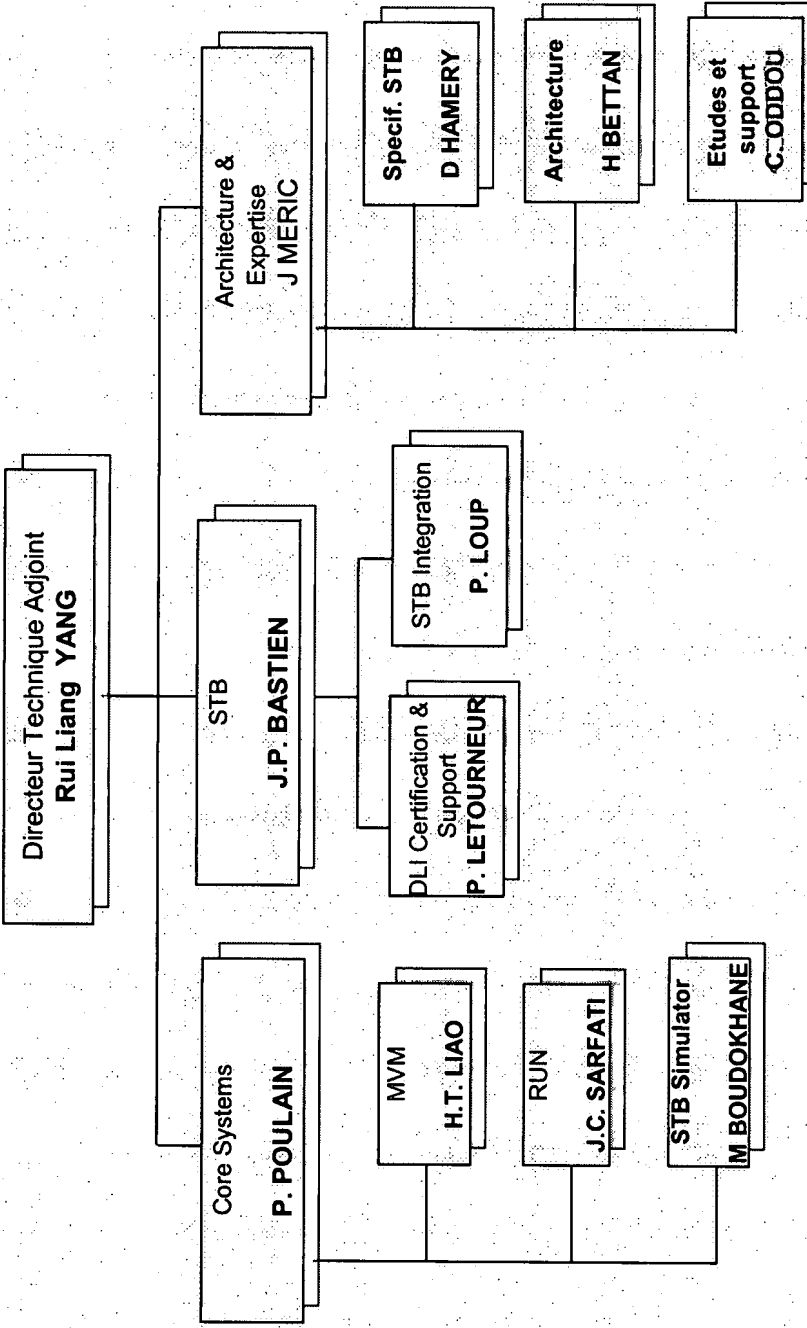
Christophe Oddou

Organigramme Direction Technique

09/05/01

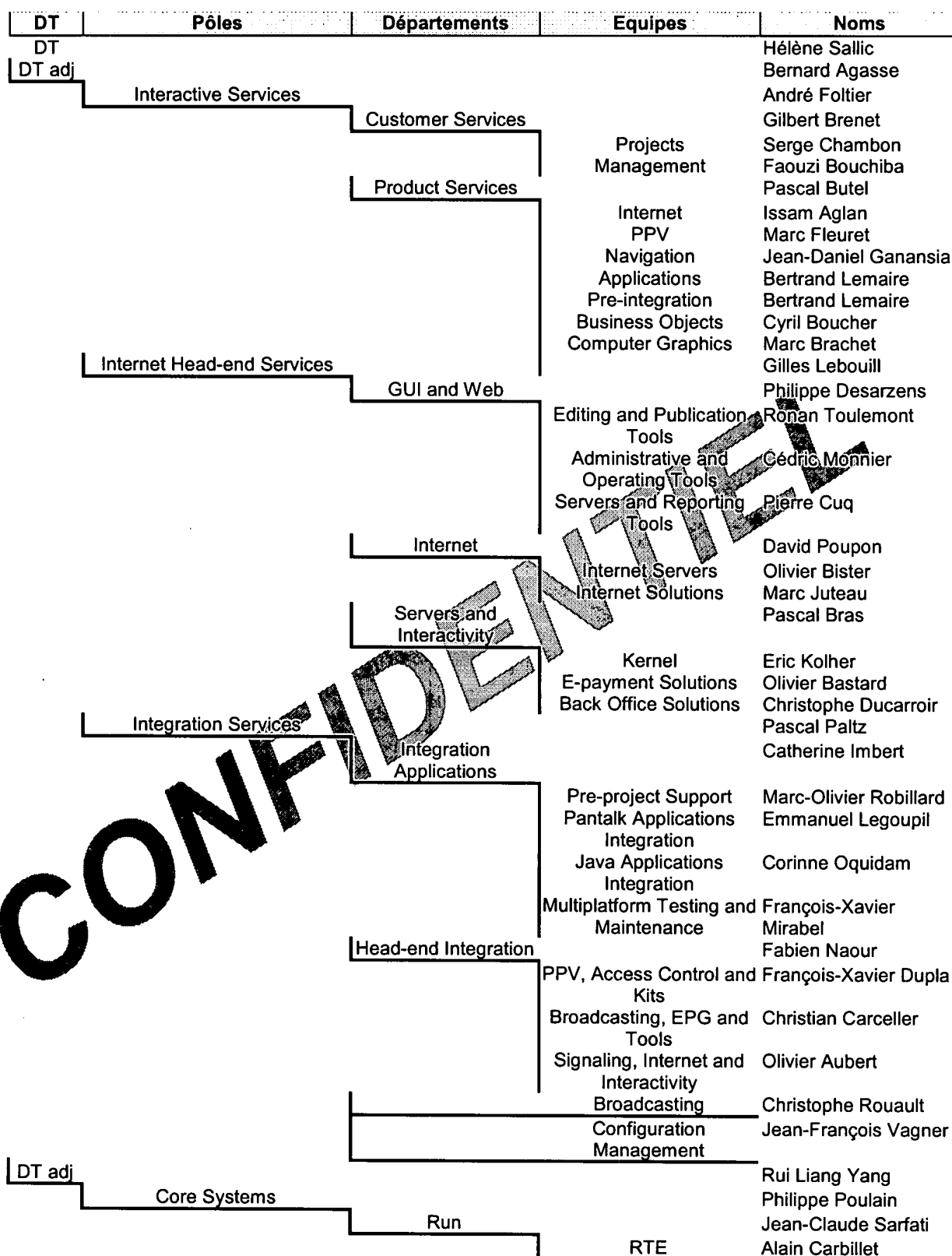


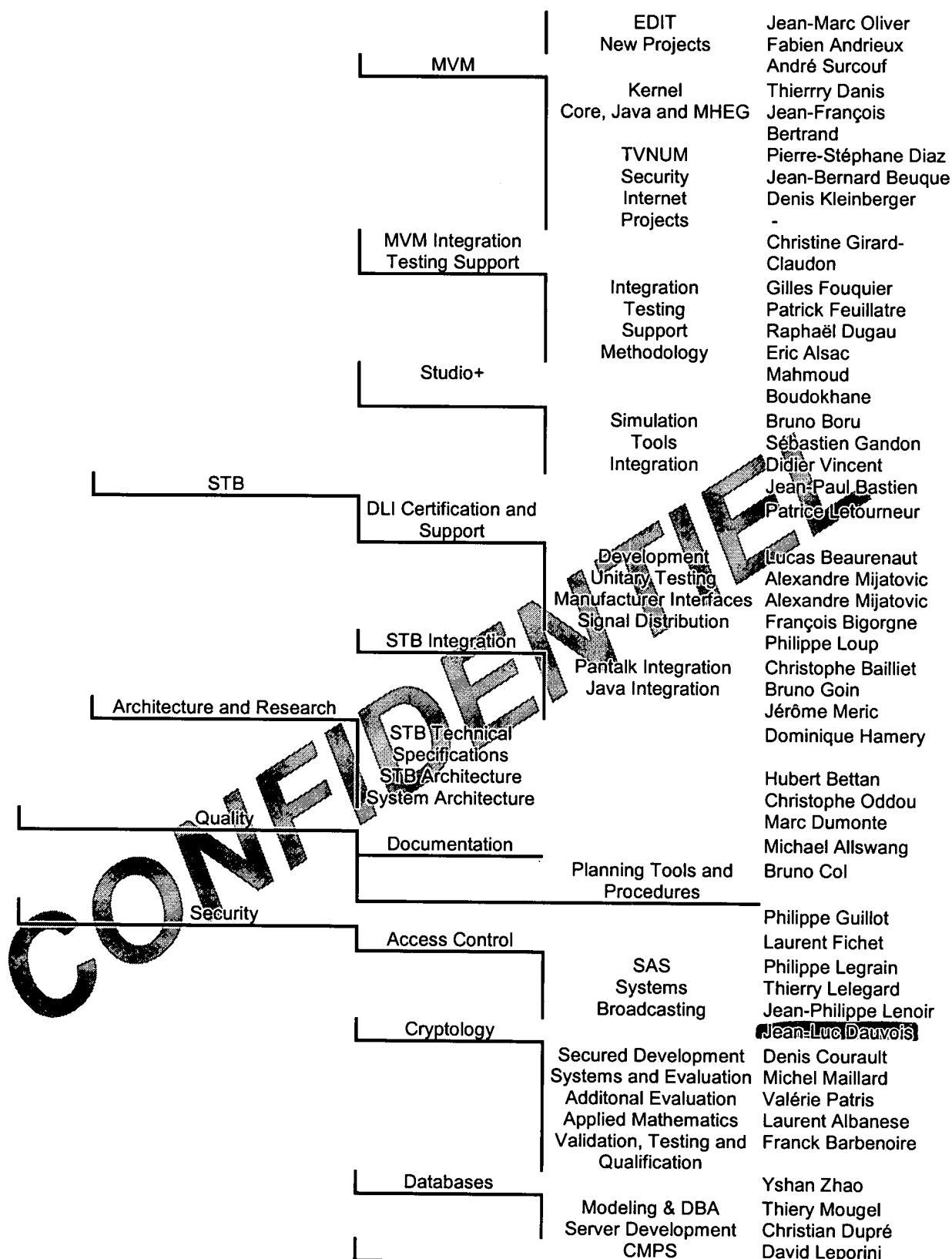
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09/05/01

4. ORGANIGRAMME DE LA DIRECTION TECHNIQUE





Bruno Weihs
Legal and Intellectual Property Department
Tel 0171715582
Fax 0171715202
Email bweihs@canal-plus.fr

By fax – confirmation by courier
Confidential

Paris, June 26, 2001

Our ref: I2001.016

Re: Declaration of invention
Title : Unique Key Computation to Encipher the Data Memories
Inventor: Jean-Luc Dauvois

Sir:

I'm pleased to forward to you herewith a new declaration of invention including a description of an invention that we would like to protect with a French Patent.

I suggest that we arrange a meeting between one of your engineer and one of our inventor in order to fill in the declaration of invention, to do a possible prior art search and to prepare first draft of a patent application.

Best regards,

Bruno Weihs

Encl. Declaration of invention

Cc. (without encl.) Jean Luc Dauvois

Ref: I2001.016

Date: November 5, 2001

From: Bertrand Allain

To: Jean-Luc Dauvois

Re: New Patent Application

Jean-Luc,

I am pleased to provide you herewith with a first draft of Patent Application prepared by Brevallex, for your review.

It is necessary that you check the accuracy and the scope of the description, together with the contents of the claims comparing to the invention.

You may return the document annotated with your comments and/or corrections, and if needed with the annotation "OK for filing" and your signature on the first page of the claims.

Best regards,

Bertrand ALLAIN

Encl. Draft of Patent application

Bertrand Allain
Director of Intellectual Property
Tel: 01 71 71 57 59
Fax: 01 71 71 52 02
Email: ballain@canal-plus.fr

Our Ref: 20022/HM
Your Ref: I2001.016

Paris, November 12, 2001

Subject: French Patent Application
Inventor: Jean-Luc Dauvois

Dear Sir,

Please find enclosed the text that you forwarded regarding the above-mentioned draft.

The draft is annotated by Jean-Luc Dauvois. I would be grateful if you would consider these suggestions of amendments. Please do not hesitate to contact the inventor if you have any questions.

Very Truly Yours,

Bertrand Allain

Encl. Annotated draft

Ref: B 2002.005

Date: April 16, 2002

From: Philippe Cassagne

To: Sebastien Montet

Re: New European Patent Application

Inventor: Jean-Luc Dauvois

Sebastien,

According to the new procedure regarding the bonus for invention, please note that..... has been designated as inventor of the French Patent Application named "Method and device of digital data protection stored in a memory". This application is a first application in the Patent family. It has been filed with the INPI on April 8, 2002 under N° 02 04321.

In accordance with this agreement, the inventor shall obtain ASAP a bonus of invention for an amount of 5 000 Francs.

I remain at your disposal if you need any further information.

Best regards,

Agreement

Philippe Cassagne

Date

Signature

Mr. Jean Luc Dauvois

Paris, April 23, 2002

Dear Sir,

I have the pleasure of informing you that pursuant to your contribution as inventor in the French Patent Application named "Method and device of digital data protection stored in a memory", filed on April 8, 2002 (ref of INPI filing 02 04321), you have been assigned a bonus for a gross amount of:

762,25 Euros

This amount will be paid with your salary of May 2002.

Sincerely yours,

Philippe Duranton
Assistant General Director
Human Resources - General Affairs